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02 OCT 2006

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In re Application of BIRD et al.
Application No.: 10/523,153
PCT No.: PCT/AU03/00954
Int. Filing: 29 July 2003
Priority Date: 29 July 2002
Attorney Docket No.: 83950
For: A BULK COMMUNICATIONS PROCESS
USING MULTIPLE DELIVERY MEDIA

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: DECISION ON PETITION
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: UNDER 37 CFR 1.47(a)
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This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 26 July 2006, to accept the application without the signatures of joint inventors, Kevin Bryan Levine and Michael Robert Stewart. Applicant's request for a three month extension of time is granted.

BACKGROUND

On 27 January 2005, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. §371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee. The transmittal letter was directed to PCT/US03/00954; however, applicant submitted a copy of international application PCT/AU03/00954. The submission was treated as a national stage application of PCT/US03/00954 and assigned U.S. application number 10/523,153. Thereafter, USPTO made a correction under 37 CFR 1.182 to application number and treated the submission as a national stage application of PCT/AU03/00954, assigned U.S. application number 10/523,153.

On 09 May 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 06 October 2005, applicant filed the instant petition along with a declaration directed to PCT/AU03/00954, executed by the joint inventors on behalf of the nonsigning inventors. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signatures of inventors Kevin Bryan Levine and Michael Robert Stewart, alleging that the inventors refuse to sign the application.

On 28 February 2006, a decision dismissing applicant's petition under 37 CFR 1.47(a) was mailed indicating that Petitioner had not demonstrated that (1) a *bona fide* attempt was made to present a complete copy of the application papers for U.S. application 10/523,153 (specification, including claims, drawings, and declaration) to the non-signing inventors for their signature and (2) both Mr. Stewart's and Mr. Levine's refusal to sign, either in writing or by telephone, these documents.

On 26 July 2006, applicant filed a renewed petition under 37 CFR 1.47(a).

DISCUSSION

Petition under 37 CFR 1.47(a)

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3) and (4) were previously satisfied.

Inventors' Refusal to Sign

With respect to Item (2) above¹, Petitioner provided the statement of Carl David Harrap, a registered Australian and New Zealand patent attorney for ConnXion, an Australian company with a proprietary interest in the application. Mr. Harrap indicates that he requested the last known addresses for both Messrs. Levine and Stewart from the ConnXion's Chief Financial Office. Apparently no attempt was made to contact their last employer for their last known addresses. On 5 July 2006, Mr. Harrap sent letters addressed to Michael Stewart and Kevin Levine with a "copy of the patent specification of the PCT application as published" and a copy of the declaration. Mr. Harrap states that the correspondence was sent via registered post with Australia Post. The Australia Post was not successful in the delivery to either address. The Post Final Notice for each addressee was attached to the statement.

The correspondence delivery address for Mr. Stewart appeared as "7 Foss Street, Forest Lodge" and for Mr. Levine, "36A Roe Street, Bondi". It is noted that the published international application provides somewhat different addresses: Mr. Levine's address as "North Bondi"; and for Mr. Stewart's address as "Glebe". No explanation of this inconsistency is provided and an explanation is required.

¹Petitioner previously provided statements of fact by Frank Anthony Favretto, Chairman of the Board of Trustees of Trade Wind Communications Limited and by Neville Zammit, Secretary of Trade Wind Communications Limited regarding the inventors' refusal to sign the application. Neither inventor was presented with a copy of the patent application along with declaration. Petitioner did not submit any further statements from Messrs. Favretto or Zammit with his renewed petition.

It is unclear from the Australian Post delivery notices, when and how many attempts were made to deliver the correspondence. No information was provided by the Australia Post service regarding whether the addressees still reside at the above address, whether they no longer live at that address and have moved and if a forwarding address was available. It may be that the attempts were made during the day when the nonsigning inventors were at work or while the inventors were on vacation. The fact that a nonsigning inventor is hospitalized, on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. See MPEP 409.03(d). A single attempt to deliver correspondence does not amount to a diligent effort to reach an inventor.

Mr. Harrap also attempted to locate the inventors using the online Australian telephone database. This is an acceptable tool to locate inventors. However, Mr. Harrap limited his attempt to "Foss Street" for Mr. Stewart and to "Roe Street" for Mr. Levine. If, in fact, the delivery addresses for the inventors are no longer valid, attempts to locate the nonsigning inventors in this limited way would not likely produce a successful result.

What is required is that both Mr. Stewart and Mr. Levine be presented with a copy of all of the national stage application papers (specification, including claims and drawings, oath or declaration) for this application. See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.² Where an inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instruction, that support a finding

² A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

that the nonsigning inventor could not be found or reached should be made part of the statement.

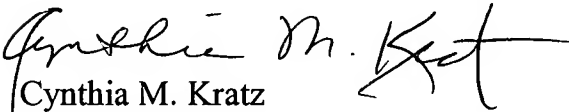
In sum, Petitioner has not satisfied Item (2). Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is DISMISSED WITHOUT PREJUDICE.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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